

REMARKS

Claims **1-2, 6-9, 12-13, 18-20, 25, and 27-52** are pending in this application. According to the November 1, 2007 Office Action, claims **1-2, 6-9, 12-13, 18-20, 25, and 27-52** are rejected.

We have amended independent claim **13**, have amended dependent claims **2, 7, 9, 12, 19, 25, 27-29, 31, 33, 35-40, and 45**, and have added new independent claim **53** to recite particular embodiments that we, in our business judgment, have currently determined to be commercially desirable. In particular, note that dependent claim **31** has been amended to be an independent claim that includes the limitations of the claims from which it depended, including independent claim **1** and dependent claim **30**. Similarly, dependent claim **33** has been amended to be an independent claim that includes the limitations of the claims from which it depended, including independent claim **1** and dependent claim **30**. We have canceled independent claims **1** and **46-47** and dependent claims **6, 8, 18, 20, 30, 34, 41-44, and 48-52**. We will pursue the subject matter of the previously presented and canceled claims in one or more continuing applications. The amendments do not introduce any new matter.

Accordingly, the following claims are under consideration:

- Independent claims **13, 31, 33, and 53**.
- Dependent claims **2, 7, 9, 12, 19, 25, 27-29, 32, 35-40, and 45**.

I. AMENDMENTS TO THE SPECIFICATION

The Specification is amended between paragraphs [0007] and [0008]. Support for the amendment may be found in claims **3** and **4** of the application as originally filed.

The Specification is also amended between paragraphs [0008] and [0009]. Support for the amendment may be found in claims **7** and **12** of the application as originally filed.

II. CLAIM OBJECTIONS UNDER 37 CFR 1.75(c)

At page 2, paragraphs 11-13 of the Office Action, the Examiner objects to previously presented claims **1, 13, 18-19, and 41-45** under 37 C.F.R. § 1.75(c). We respectfully disagree with the objection to the claims. Nonetheless, to expedite prosecution of the application, claims

13, 19, and 45 have been amended. In view of the amendments and canceled claims, the objection is now moot.

III. REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

At pages 3-4, paragraphs 14-16 of the Office Action, the Examiner rejects the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

First, regarding the Examiner's assertion that certain claim limitations do not find antecedent basis in the specification as filed, assuming, *arguendo*, that by this assertion the Examiner means that the terms of the claims must be found literally within the specification as filed and/or that the specification must be amended to literally include the terms of the claims, such a rejection under 35 U.S.C. § 112, first paragraph, has no basis. See MPEP 2163.02 ("The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.").

Second, in response to the Examiner's rejections, support for the claimed subject matter may be found in the application as follows (the paragraph numbers are with respect to the publication of the application (i.e., Patent Application Publication No.: US 2003/0139998) and the line numbers are with respect to each paragraph):

1. **"plurality"**: Support may be found, for example, at paragraph [0007], lines 4-5, and at paragraph [0014], lines 1-2.
2. **"matching at least in part"**: Support may be found, for example, at paragraph [0018], lines 1-3, and at paragraph [0020].
3. **"filling at least in part"**: Support may be found, for example, at paragraph [0014], lines 10-13, at paragraph [0015], at paragraphs [0019]-[0020], and at paragraph [0021], lines 8-12.
4. **Claims 6 and 8 –"selecting the bid-offer liquidity spread"**: Previously presented claim **8** does not recite "selecting the bid-offer liquidity spread," as the Examiner asserts. It appears the Examiner may be referring to claim **48** and we will proceed under that assumption. Because claims **6, 8, and 48** (and similar claims) have been canceled, this rejection is now moot.

5. **Claims 6 and 8 – “proximity”**: Previously presented claim 8 does not recite “proximity,” as the Examiner asserts. It appears the Examiner may be referring to claim 48 and we will proceed under that assumption. Because claims 6, 8, and 48 (and similar claims) have been canceled, this rejection is now moot.
6. **Claim 7 (and similar claims) – “an average between a midpoint of the second bid-offer liquidity spread and a last-executed trade price”**: Support may be found, for example, at the first new paragraph added between paragraphs [0008] and [0009], at paragraph [0031], and at paragraph [0032], lines 8-10.
7. **“midpoint”**: Support may be found, for example, at the first new paragraph added between paragraphs [0008] and [0009], at paragraph [0031], and at paragraph [0032], lines 8-10.
8. **Claim 12 – “a buy price that is lower ...”**: Support may be found, for example, at the second new paragraph added between paragraphs [0008] and [0009], at paragraph [0015], at paragraph [0019], and at paragraph [0032], lines 4-8.
9. **Claim 25 – “first rules ...”**: Support may be found, for example, at paragraph [0007], lines 1-4, at the new paragraph added between paragraphs [0007] and [0008], and at paragraph [0030], lines 1-5.
10. **Claim 27 (and similar claims) - “a portion”**: Support may be found, for example, at paragraph [0018], lines 1-3.
11. **using liquidity provided ...”**: Support may be found, for example, at the second new paragraph added between paragraphs [0008] and [0009], at paragraph [0014], lines 10-13, at paragraph [0015], at paragraph [0019], at paragraph [0021], lines 8-12, and at paragraph [0034]
12. **Claim 32: “calculating an average ...”**: Support may be found, for example, at paragraph [0019], and at paragraph [0032], lines 4-8.
13. **Claim 35: “in which the crossing price ...”**: Support may be found, for example, at paragraph [0019], and at paragraph [0032], lines 4-8.
14. **Claim 36: “in which the crossing price ...”**: Support may be found, for example, at paragraph [0019], and at paragraph [0032], lines 4-8.

15. **Claim 39** (and similar claims) : **“in which filling at least in part ...”**: Support may be found, for example, at paragraph [0014], lines 10-13, at paragraph [0015], at paragraphs [0019]-[0020], and at paragraph [0021], lines 8-12.

IV. REJECTION OF THE CLAIMS UNDER 37 C.F.R. 1.75(d)

At pages 3-4, paragraph 16 of the Office Action, the Examiner objects to the specification under 37 C.F.R. § 1.75(d)(1) “as failing to provide proper antecedent basis for the claimed subject matter.”

Again, assuming, *arguendo*, that by the Examiner’s objection the Examiner means that the terms of the claims must be found literally within the specification as filed and/or that the specification must be amended to literally include the terms of the claims, such an objection under 37 C.F.R. § 1.75(d)(1) has no basis. Specifically, we draw the Examiner’s attention to 37 C.F.R. § 1.75(d)(1), which states in part that “the terms and phrases used in the claims must find clear **support or** antecedent basis in the description.” (emphasis added). We also draw the Examiner’s attention to the MPEP 608.01(o), which state in part that “... an applicant is not limited to the nomenclature used in the application as filed”

In response to the Examiner’s objection, “support” for the claimed subject matter may be found in the specification as noted above.

V. “PLURALITY”

At page 3, paragraph 16 bullet “a” of the Office Action, the Examiner, with reference to the term “plurality,” asserts that it “appears that the term[] is referring to ‘one or more’ as recited by the original disclosure. By this assertion the Examiner appears to be rejecting the claims as being indefinite. Such a rejection is improper under 35 U.S.C. § 112, first paragraph, and under 37 C.F.R. § 1.75(d) but rather, should be raised under 35 U.S.C. § 112, second paragraph.

Assuming the Examiner is making such a rejection, we draw the Examiner’s attention to MPEP § 2173.02, which states in part that under 35 U.S.C. § 112, second paragraph,

[t]he requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles.... **Only when a claim remains insolubly ambiguous without a discernible meaning** after all reasonable attempts at construction must a court declare it indefinite.

(emphasis added).

Because the Examiner fails to show that the term “plurality” is “insolubly ambiguous without a discernible meaning,” any apparent rejection of the claims under 35 U.S.C. § 112, second paragraph, is improper. Nonetheless, we respectfully submit that one skilled in the art would discern “plurality” to mean at least two (i.e., two or more).

VI. REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

At pages 4-5, paragraphs 17-18 of the Office Action, the Examiner appears to reject previously presented claims **6** and **48** under 35 U.S.C. § 112, second paragraph, as being indefinite. While we disagree with the rejection, the rejection is now moot in that these claims have been canceled.

VII. REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 103

At pages 5-17, paragraphs 19-21 of the Office Action, the Examiner rejects the claims under 35 U.S.C § 103(a) as being unpatentable over Rickard et al., International Publication No. WO 98/12659 (hereinafter Rickard).

A. Independent Claim 31

As indicated, claim **31** has been amended to be an independent claim that includes the limitations of the claims from which it depended, including independent claim **1** and dependent claim **30**. Claim **31** recites in part:

selecting a bid-offer liquidity spread from the plurality of bid-offer liquidity spreads;

calculating, based on the selected bid-offer liquidity spread, a first crossing price;

filling the matched orders at the first crossing price;

calculating, based on the selected bid-offer liquidity spread, a second crossing price; and

filling at least in part the order imbalance at the second crossing price

The Examiner asserts that Rickard discloses such limitations at page 13, lines 19-33 and at page 19, lines 1-21 (see rejection of claims **30** and **31** at page 10 of the Office Action), but fails to provide any explanation as to the pertinence of these portions of Rickard to the claim limitations. The Examiner merely asserts that all the above noted claim limitations are disclosed at these portions of Rickard .

We draw the Examiner's attention to 37 C.F.R. § 1.104(c)(2), which sets the minimum standards for any validly-issued Office Action:

§ 1.104 Nature of examination.

(c)Rejection of claims.

(2)In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In other words, in situations where a reference discloses anything more than the invention claimed, as here, Rule 1.104 requires the Office Action: (i) to “designate” the particular part of the reference relied on and, (ii) to “clearly explain” the pertinence of the reference when not apparent. The pertinence of Rickard page 13, lines 19-33 and page 19, lines 1-21 to the above noted claim limitations is not apparent, nor does the Examiner provide any explanation as to pertinence of these portions of Rickard to the above noted claim limitations. In addition, it is not an applicant's duty to guess at the Examiner's position. *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (Bd. Pat. App. & Interf. 2000) (applicants are not required to “guess as to the basis of the rejection”). For example, at Rickard page 13, lines 19-33 and page 19, lines 1-21:

- a. What does the Examiner consider to be “*a bid-offer liquidity spread*” and where is such a spread “*select[ed]*”?
- b. What does the Examiner consider to be “*a first crossing price*,” and where is such a price “*calculate[ed] based on the selected bid-offer liquidity spread*”?
- c. What does the Examiner consider to be “*a second crossing price*,” and where is such a price “*calculate[ed] based on the selected bid-offer liquidity spread*”?

Because the Examiner fails to provide any explanation as to pertinence of Rickard page 13, lines 19-33 and page 19, lines 1-21 to the above noted claim limitations, the Examiner clearly

violates the requirements of 37 C.F.R. § 1.104(c)(2). Accordingly, the Office Action is procedurally inadequate to raise any rejection of claim **31** and fails to establish a *prima facie* case of obviousness of this claim.

B. Independent Claim 13

Independent claim **13** recites limitations similar to claim **13** and as such, Rickard has not been shown to teach, suggest, or disclose all the limitations of this claim for at least the same reasons set for above for claim **31**.

C. Independent Claim 33

As indicated, claim **33** has been amended to be an independent claim that includes the limitations of the claims from which it depended, including independent claim **1** and dependent claim **30**. Claim **33** recites in part:

selecting a first bid-offer liquidity spread from the plurality of bid-offer liquidity spreads;

calculating, based on the first bid-offer liquidity spread, a first crossing price;

filling the matched orders at the first crossing price;

selecting a second bid-offer liquidity spread ...;

calculating, based on the second bid-offer liquidity spread, a second crossing price; and

filling at least in part the order imbalance at the second crossing price....

The Examiner asserts that Rickard discloses such limitations at page 13, lines 19-33, at page 14, line 29, and at page 15, line 11 (see rejection of claims **30** and **33** at pages 10-11 of the Office Action). Similar to claim **31**, the pertinence of these portions of Rickard to the above noted claim limitations is not apparent, nor does the Examiner provide any explanation as to pertinence of these portions of Rickard to the above noted claim limitations. In addition, it is not an applicant's duty to guess at the Examiner's position. For example, at Rickard page 13, lines 19-33, page 14, line 29, and page 15, line 11:

- a. What does the Examiner consider to be “*a first bid-offer liquidity spread*” and where is such a spread “*select[ed]*”?
- b. What does the Examiner consider to be “*a second bid-offer liquidity spread*” and where is such a spread “*select[ed]*”?
- c. What does the Examiner consider to be “*a first crossing price*,” and where is such a price “*calculate[ed] based on the first bid-offer liquidity spread*”?
- d. What does the Examiner consider to be “*a second crossing price*,” and where is such a price “*calculate[ed] based on the second bid-offer liquidity spread*”?

Because the Examiner fails to provide any explanation as to pertinence of Rickard page 13, lines 19-33, page 14, line 29, and page 15, line 11 to the above noted claim limitations, the Examiner clearly violates the requirements of 37 C.F.R. § 1.104(c)(2). Accordingly, the Office Action is procedurally inadequate to raise any rejection of claim **33** and fails to establish a *prima facie* case of obviousness of this claim.

D. Dependent Claims 2, 7, 9, 12, 19, 25, 27-29, 32, 35-40, and 45

Because dependent claims **2, 7, 9, 12, 19, 25, 27-29, 32, 35-40, and 45** depend from claims **13, 31, and 33**, Rickard has not been shown to teach, suggest, or disclose all the limitations of these claims for at least the same reasons set for above for claims **13, 31, and 33**.

VIII. NEW INDEPENDENT CLAIM 53

New independent claim **53** recites limitations similar to claim **33** and as such, Rickard has not been shown to teach, suggest, or disclose all the limitations of this claim for at least the same reasons set for above for claim **33**.

IX. CONCLUSION

In view of the remarks, we respectfully submit that the claims are in condition for allowance. We request that the application be passed to issue in due course. The Examiner is urged to telephone our undersigned representative at the number noted below if it will advance

the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Respectfully submitted,

/Glen R. Farbanish/

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Date

Glen R. Farbanish
Reg. No. 50,561
(212) 294-7733